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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/083,793	05/22/98	MURPHY	B 17634-000320

HM21/1222
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EXAMINER	
MOSHER, M	
ART UNIT	PAPER NUMBER
1643	

DATE MAILED: 12/22/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/083,793

Applicant(s)
Murphy et al

Examiner
Mary Mosher

Group Art Unit
1643



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-128 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-128 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1643

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-47, 94, 97-99, 101, 107-115, 121-128, drawn to polynucleotide encoding the genome of a chimeric parainfluenza virus, mutated parainfluenza virus, or parainfluenza virus comprising heterologous sequence; viruses or particles having chimeric genome or comprising heterologous sequence; and compositions comprising said virus particles; classified in class 536, subclass 23.72, for example.
- II. Claims 48-90, drawn to method for producing parainfluenza virus using expression vector encoding N, P, and L products, and materials used in the method, classified in class 435, subclass 472 for example.
- III. Claims 91-93, 100, 102-106, 116, 118-120, drawn to viruses and subviral particles, classified in class 435, subclass 235.1 for example.
- IV. Claim 95, drawn to infectious parainfluenza virus particle comprising DNA, classified in class 435, class 472 for example.

Claim 117 has not been included in the grouping, as prior to examination it is not clear whether claim 117 belongs in group I, group III, or contains species of both groups. If group I or III is elected, claim 117 will be examined to the extent that it reads upon the elected group.

The inventions are distinct, each from the other because of the following reasons:

Art Unit: 1643

Invention III is related to groups I-II as product and process of making. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, viral particles or subviral particles having the same characteristics can be made by a materially different process, such as isolation from wild-type virus, or by isolation from virus stocks selected for phenotypic alteration by classical virological methods. While the claims recite "a recombinant PIV genome", these claims do not recite any definite characteristics conferred upon the genome by a "recombinant" process. Therefore, the claims are seen as product-by-process claims, and encompass materials that have the same characteristics made by other processes.

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the nucleic acids can be used in a method involving helper virus rather than expression vectors, and the particles can be made by a method involving helper virus rather than expression vectors.

Invention IV is distinct and unrelated to inventions I-III. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, a particle which comprises DNA has different modes of operation and function and

Art Unit: 1643

different uses and different effects from a parainfluenza virus particle, which packages parainfluenza virus RNA.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent search requirements, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is (703) 308-2926. The examiner can normally be reached on Monday -Thursday and alternate Fridays from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for this Group is now (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

December 21, 1998

Mary Mosher
MARY E. MOSHER
PRIMARY EXAMINER
GROUP 1200

1600